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P R O C E E D I N G S

MR. HIEKEN: Good morning, Your Honors. Thank you for reassembling to hear this appeal on the same invention again.

Your Honors, may it please the Board, this is a third appeal from the final rejection of claims 1, 6 and 11 to a key ring and method of making under section 103 as unpatentable over Chen as a primary reference, in view of Jung as a secondary reference and Momemers as a tertiary reference. Claims 2 and 4 are additionally rejected in view of Miller as a quaternary reference.

The rejection of claims 3 and 5 on Mr. Perthou's design patent has been withdrawn. So therefore, I believe those claims are now allowable.

I will discuss the claim construction, the prior art, differences and law.

The first thing that we need to do and I think we're all agreed on it, is that we need to construe the claims in the light of the specification as one of ordinary skill in the art would construe them.

Now, in this particular field, which is designing a key ring and all, the level is not as high as, say, the ordinary skill of one working in the advanced bio industry. And when we look at, for example, the patent piece in the references, the person of ordinary skill is a little below those people because they are people of extraordinary skill.

Now, if you'll look at the claims in light of the -- to be construed in the light of the specification, it has a key holding ring, a D-ring which couples the key holding ring to the web and the D-ring has a gap in the bar that joins the ends of the U portions.

Now, I counted the word D-ring on the first page of the published application, excluding the use in the claim there, 16 times. So it is rather

1 clear that one skilled in the art, of ordinary skill in the art reading that
2 specification would recognize that this is a D-ring, which looks like the letter
3 D and not anything else that has been, I think, assigned as possible D-ring,
4 like the ring 3, I think, in Momemers. But that key retaining loop is just not
5 a D-ring.

6 So we look at the prior art, we know that Chen is two rings joined by
7 a strap. Jung shows that nail clipper supporting a key ring by a bent wire
8 with the legs 90 degrees apart and has two little protrusions at the end that fit
9 into the body of the nail clipper to which it is attached.

10 Momemers has a key retaining loop but that is not a D-ring. If you
11 look at what the purpose of his particular key holder is, I think that that
12 particular loop gets pushed out so you can put in your keys if you want.

13 JUDGE OWENS: Is it shaped like a D?

14 MR. HIEKEN: No, it is not, Your Honor. It is not a D. She says it
15 is, but it isn't.

16 JUDGE KERINS: Counsel, aren't there different ways to write the
17 letter D?

18 MR. HIEKEN: It looks something -- maybe some distortion of a C or
19 something like that. But a D-ring looks like the letter D. And we even
20 attached, I think, a definition that we had picked up off the Net to further
21 reinforce it.

22 This is a D-ring and anything of the form of that loop 3 in the tertiary
23 reference is just not a D-ring.

24 So let's go into the law. A fundamental decision that we have, I don't
25 know whether we mentioned it in this Brief or not, is *Ex parte Holt* which
26 was a decision by the Board where they assembled a large number of

1 examiners-in-chief or administrative law judges and they say, we are going to
2 follow all the decisions of the Federal Circuit and the Patent Office; and in
3 the case where we don't have, say, Federal Circuit decisions and the like,
4 then we would follow published decisions of the Board of Appeals.

5 So we have the decisions of *In re Martin*, *In re Hughes*, which says
6 that a reference is only good for what it clearly and definitely discloses.

7 And if you go to *In re Fritsch*, it says you can't use the claim being
8 rejected as a blueprint or a template for going around and looking for prior
9 art types of devices.

10 Then with respect to claim 11, which is just the method of it, there is
11 the decision of *Ex parte Rubin* which was cited in the prior Brief but for
12 some reason wasn't in this one. And the express quotation there is, in the
13 absence of the article in the prior art, we find no basis for the conclusion that
14 the manipulative steps of assembling the nonexistent article would be
15 obvious.

16 That's *Ex parte Rubin* 127 USPQ 286 at 287.

17 And since no prior art shows the recited D-ring, at least for that reason
18 it's impossible to combine the references to meet the limitations of the claim
19 and that ought to be reason enough for withdrawing the rejection of them.

20 JUDGE KERINS: Counsel, did we not decide this issue in the
21 previous appeal, that the combination of the art does disclose a D-ring?

22 MR. HIEKEN: I don't recall you citing -- I don't recall you citing
23 these decisions upon which we relied for -- I know that *Ex parte Rubin*
24 wasn't cited and I don't remember. I have the decision here and I don't
25 remember those decisions that we relied on, including *Ex parte Cusco* that
26 was a published decision being cited in the prior Appeal.

1 Now, let me give you a little background of that particular decision.
2 Examiner in Chief Henin came up to Boston one year, the Boston Harbor
3 Hotel, for a talk to the Boston Patent Law Association. And in the course of
4 his talk he asked for questions. So I asked him, I says, what about the
5 situation where it is impossible to combine what is found in the prior art to
6 meet the limitations of the claim?

7 And he said, That's one of the strongest reasons for finding an
8 invention patentable over such prior art.

9 And it was he who wrote the opinion in *Ex parte Cusco*. Now, the
10 way that we need to evaluate these inventions -- and it's not easy because
11 once an invention is made, it's very, very easy to say, oh, yeah, that can be
12 done and that can be obvious by hindsight, which of course we're not
13 supposed to use.

14 But I remember an opinion written by Judge Rich some years ago
15 where he talked about the situation, well, what you do is you set this man of
16 ordinary skill in the art in a room and you put the prior art up around the
17 walls and then you figure out, well, what did this man come up with.

18 And what Judge Rich was suggesting was that in order to reject an
19 invention on prior art, that what the hypothetical person of ordinary skill
20 must do is to construct the invention from the prior art. Not reconstruct the
21 invention by hindsight, as was done in this particular case and violate the
22 rules of *In re Fritsch* by just going around and looking at elements of the
23 claims and say, I find this one and this one and this one.

24 So the advantages of the invention are set forth, I think, in paragraphs
25 19 and 20 of the published application. It does have advantages which are

1 just how you move it around like this, you have a nice hold on it, this can be
2 then like this and like this.

3 It is something that Mr. Perthou, who is a very capable individual
4 inventor, came up with this and has persisted for over a decade in saying,
5 look, I believe I am entitled to a patent.

6 And based on the absence of pertinent prior art and based on properly
7 interpreting the claim and properly applying the precedents he is right and
8 we respectfully urge you to reverse the final rejection and allow the claims.

9 JUDGE OWENS: Suppose Momemers' ring 3 were shaped like what
10 you consider to be a D. Then what would be wrong with the rejection?

11 MR. HIEKEN: What would be wrong with what?

12 JUDGE OWENS: What would be wrong with the rejection if
13 Momemers' ring 3 were shaped like what you consider to be a D?

14 MR. HIEKEN: There's no suggestion. Just putting those around to a
15 person of ordinary skill in the art, when he sees something like that is he
16 going to put it together and come up with the reasoning that Mr. Perthou
17 came up to achieve the advantages that are achieved with a combination?

18 It is the subject matter as a whole that must be obvious to one of
19 ordinary skill in the art at the time the invention was made which was first
20 back in something like 2000 or some such thing like that. And the subject
21 matter as a whole would also include the reasons for producing and doing
22 the combining that Mr. Perthou expressed in his application that should be
23 considered also.

24 And there's nothing in any of the references which discuss any of that
25 type of reasoning. And a person of ordinary skill in the key hole art is not
26 going to come up with this invention. They never have.

1 JUDGE LORIN: Counsel, let's see if I can advance the argument a
2 little bit. You are not making the argument that the only difference between
3 your invention and the prior art is that you have a D-ring, correct?

4 MR. HIEKEN: I'm sorry, Your Honor, what?

5 JUDGE LORIN: Your only argument is not that the difference
6 between your invention and that of the prior art is that you have a D-ring? Is
7 that your argument?

8 MR. HIEKEN: Say again, please. Sorry.

9 JUDGE LORIN: Your only argument is not that your invention is a
10 D-ring as opposed to that of the prior art?

11 MR. HIEKEN: No. It's a combination.

12 JUDGE LORIN: Did you want to speak a little bit as to this gap?
13 Because I see in your Brief that you discuss this gap.

14 MR. HIEKEN: Yes, because also it has to do with the reasoning in *Ex*
15 *parte Rubin*. I remember that had some kind of insulation or some such
16 thing like that.

17 Yes, because for one thing you would like to have it be as solid as you
18 can, as small a gap as you can so that when you are pulling on this web here,
19 you are going to have a secure connection to that bar and yet, you want to be
20 able to assemble it too. So therefore, by putting -- making that gap in there
21 small, which is about the cross-section of the key holding ring, then you can
22 assemble it in accordance with the method at claim 11 and you will still have
23 the strength of having a nearly full length bar in the D-ring to attach the web
24 to.

25 JUDGE LORIN: Can you explain the significance in your claim of a
26 limitation that the gap width must be about that of the cross-sectional span?

1 MR. HIEKEN: Yes. So that you are able to slide the key holding
2 ring through there during assembly and yet you don't -- if you make it
3 bigger, if you look at the nail clipper one, you can see that when that holds
4 on, that's very, very little length of connection between the nail clipper and
5 that wire that's connecting the key ring to the nail clipper. This has a real
6 secure connection to the web which you can use as a holder. It's a good
7 holder.

8 JUDGE KERINS: Counsel, is it your position that the Momemers
9 reference does not disclose a ring that meets that limitation with the gap?

10 MR. HIEKEN: Yes, it is. Absolutely stand on that. Yes.

11 JUDGE KERINS: How do we measure the term about that of the
12 cross-sectional span? How far do we go with about?

13 MR. HIEKEN: I think for that about the cross-section is just basically
14 big enough to get it through. Because after all, you interpret the claims in
15 the light of the specification and the descriptions. The description explains
16 the method of how you put it through. So I think that that is adequate to
17 enable a person to know the differences between, say, infringing and
18 noninfringing conduct, by interpreting it in the light of the description.

19 JUDGE OWENS: No more questions. Thank you.

20 MR. HIEKEN: Thank you very much for your attention. I appreciate
21 it.

22 (Whereupon, at 9:17 a.m., the proceedings were concluded.)